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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,558	07/11/2003	Peter Gansen	64215-028 CIP	5170

30743 7590 08/30/2006

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/618,558

Applicant(s)

GANSEN ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/861,330.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Antecedence has not been found within the specification for claiming that the molecular weight of claim 11 is weight average molecular weight.

Applicants' amendment to the specification has not addressed the issue. Average molecular weight is not equivalent to weight average molecular weight.

2. The amendment filed June 21, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment specifying the molecular weight as being "average".

Applicant is required to cancel the new matter in the reply to this Office Action.

As aforementioned, average molecular weight is not equivalent to weight average molecular weight.

3. Claims 2 and 4-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claims 17, 18, and 23, applicants have claimed an optically clear polyurethane gel including course-grain particles; however, it is unclear how the gel can be clear since it includes opaque particles. It is not clear if the "optically clear" limitation is to apply to the gel sans particles.

Secondly, the subject matter of claim 23 fails to further limit claim 18.

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Thirdly, with respect to claims 4, 17, 18, and 30, it is unclear what limitation is to be conveyed by “substantially”. Applicants have provided no guidance as to how this term is to be interpreted.

4. Claims 2 and 4-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to provide adequate support for the amendments to claims 4, 17, 18, and 25-30. Firstly, support has not been provided for the various occurrences of “substantially”, and no definition has been provided to permit one to determine what is meant by the language. Secondly, support has not been provided for “about 1 mm”, “about 0.1 mm”, and “about 1.5 kg per liter”. Lastly, support has not been provided for the claimed values of the properties within claims 26-30. Examples can only provide support for the exact value, as it pertains to the exemplified composition. For example, the examples are insufficient to provide support for all values that are encompassed by “about 0.44” for all compositions that are encompassed by the claims.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2 and 4-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schapel et al. ('834) in view of Ehrlich, Jr. ('702) and Fracalossi et al. ('221).

Schapel et al. disclose polyurethane gel compositions, suitable for use as pressure distributing elements, such as seat cushions, mattresses, and shoe components, wherein the gel composition corresponds to applicants' claimed gel matrix component. See abstract and columns 1-11. Patentees further disclose that the polymer may contain fillers. See column 7, lines 3+. Furthermore, given that the gels of the reference and gels of applicants are produced from the same reactants in the same ratios and given applicants' statement within line 11 of page 1 of the specification, the position is taken that compositions of Schapel et al. are clear.

7. Though the primary reference discloses the use of fillers, Schapel et al. fail to specifically recite the use of coarse materials to form a composite. However, the use of materials considered to correspond to applicants' claimed coarse particles within a polyurethane matrix, to be used as shoe soles, cushions, and mattresses, was known at the time of invention. Ehrlich, Jr. discloses the attendant advantages of incorporating wood or cork particles within a polyurethane matrix, to be used as a shoe sole. See column 2, lines 37+. Fracalossi et al. disclose that such materials as

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particulate foam, cork, and sawdust are added to a polyurethane to improve its physical properties. See column 3. Fracalossi et al. further disclose that the materials may be used as cushions and mattresses. See abstract.

8. Therefore, the position is taken in view of the aforementioned teachings within the secondary references that it would have been obvious to incorporate “coarse” particulate materials into the composition of Schapel et al., so as to obtain materials having improved properties as compared to the properties of the non-particulate containing compositions.

9. Applicants’ arguments have been considered; however, the response is insufficient to overcome the prior art rejection. Firstly, given the nature and composition of the disclosed particles of the references, the examiner disagrees with applicants’ position that the particles are not of a size comparable to that of applicants. Specifically, with respect to Fracalossi et al., the foam particles or chips are disclosed as being approximately 6 to 12 mm in diameter. See column 4, lines 16. Applicants’ argued size range does not apply to the particles at issue. Furthermore, given that the examples are not commensurate in scope with the claims, applicants have failed to demonstrate that their claimed properties are critical.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

R. Sergent  
June 25, 2006